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SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER	
ALAM, FAYYAZ	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,533	NIEMI ET AL.	
	Examiner	Art Unit	
	Fayyaz Alam	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2007 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1 - 37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant further argues on pg 24 with regards to claim 1 that the office action fails to disclose "sending a subscriber message... at the first network element".

Examiner respectfully disagrees.

Bobde clearly discloses sending notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) from the presence agent (152) (read as second network element) to the registrar or registration program (154) (read as first network element and registrar server; examiner takes note that it is not explicitly disclosed in paragraph [0028] but it is stated that one of the tasks of the presence agent (152) is to "generate notifications of changes" which

would inherently be sent or queried to the "registrar" since that is where the user registration resides), wherein the change in the presence of computing devices (read as event) is an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first entity; [0028]). Nevertheless, it is further reiterated in the rejection below that this limitation is obvious.

Applicant further argues on pg. 24 that the office action does not disclose "maintaining, in a communication system...information is dependent on the registration informaiton".

Examiner respectfully disagrees.

Bobde clearly discloses a presence agent (152) (read as second network element and presence server) for maintaining presence information (read as information) associated with said user (103) and user (107) (read as plurality of users), wherein said presence agent (read as second element) information is dependent on the registration information ([0028]; [0029]; figure 3).

In response to applicant's argument on pg. 26 that Wang cannot be combined with Bobde because Wang refers to notification about the wrong kind of information, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is from the examiner, i.e., person of ordinary skill in the art.

Therefore, rejection of claims 1 - 37 still stand. Please also see rejection below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 - 7, 11 - 18, 19 - 30, and 34 - 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142),** in view of **Wang (USPN 2002/0131395)** and further in view of **Requena (USPN 2007/0124472).**

Consider **claims 1 and 34**, Bobde et al. disclose a method in a communication system (see title), the system comprising:

a registrar or registration program (154) (read as first network element and registrar server) for maintaining registration information (see [0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph [0029] to process registration information, therefore it inherently maintains registration) from user (103) and user (107) (read as plurality of users; see figure 3)

a presence agent (152) (read as second network element and presence server) for maintaining presence information (read as information) associated with said user (103) and user (107) (read as plurality of users), wherein said presence agent (read as

second network element) information is dependent on the registration information ([0028]; [0029]; figure 3), and said method comprising:

sending notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) from the presence agent (152) (read as second element) to the registrar or registration program (154) (read as first entity and registrar server; examiner takes note that it is not explicitly disclosed in paragraph [0028] but it is stated that one of the tasks of the presence agent (152) is to "generate notifications of changes" which would inherently be sent or queried to the "registrar" since that is where the user registration resides), wherein the change in the presence of computing devices (read as event) is an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first element; [0028]);

receiving at the registrar or registration program (154) (read as first element and registrar server) a register message ([0028]) from at least user (103) (read as one user), said message changing the registration information (by way of processing presence information) of said at least user (103) (read as one user) ([0028]);

The invention as disclosed by Bobde et al. does not explicitly disclose sending a notification from the first element and registrar server to the second element and presence server in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses an application server (read as first element and registrar server)

forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, in the related field of endeavor Requena clearly discloses second network element separate from the first network element (see figs. 8, 10, 15, 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang with the teachings of Requena in order to reduce loading in one server and provide more efficient processing.

Consider **claims 2, 19, and 25** in view of claims 1, 17, and 18, Bobde et al. as modified by Wang disclose a method, where an event header (read as event package [0030]; since the header inherently defines the type of package) is defined, the event header (read event package) being associated with said change in presence of computing device (read as an event) ([0030]).

Consider **claims 3, 20, and 26** in view of claims 2, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein a registrar or a registration program (154) (read as first entity; [0029]) is defined.

Consider **claims 4, 21, and 27** in view of claims 3, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein the change in registration information relates to presence information ([0028]).

Consider **claims 5, 22, and 28** in view of claims 4, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein a presence agent (152) (read as second entity) is a presence server ([0028]).

Consider **claims 6, 23, and 29** in view of claims 1, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein the system (read as invention) operates in accordance with a session initiation protocol or SIP ([0022]).

Consider **claims 7, 24, and 30** in view of claims 6, 17, and 18, Bobde et al. fail to disclose the method, wherein the subscribe message comprises a SIP SUBSCRIBE message, and the notification comprises a SIP NOTIFY message.

In the related field of endeavor, Wang discloses SIP SUBSCRIBE/NOTIFY message for subscription and notification of presence status ([0078]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to use the conventional and well-known communication messages in session initiation protocol to comply with industry standard and furthermore conserve financial resources.

Consider **claim 11**, Bobde et al. disclose a communication system (see title) comprising:

a registrar (154) (read as first network element and registrar server) for maintaining registration information ([0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph [0029] to process registration information, therefore it inherently maintains registration) from user (103) and user (107) (read as plurality of users; see figure 3);

a presence agent (152) (read as second network element and presence server) for maintaining presence information (read as information) associated with said user (103) and user (107) (read as plurality of users), wherein said presence agent (read as second network element and presence server) information is dependent on the registration information ([0028]; [0029]; figure 3);

said presence agent (152) (read as second network element and presence server) operable to send notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) to the registrar (154) (read as first network element and registrar server), and said registrar or registration program (154) (read as first network element and registrar server) operable to receive a register message ([0028]) from at least user (103) (read as one user), said register message changing the registration information (by way of processing presence information) of said at least user (103) (read as one user), wherein the change in the presence of computing devices (read as event) is associated with the introduction of a user to the network (read as change in registration information; [0028]) of at least user

(103) or user (107) (read as one of the plurality of users at the first entity and registrar server; [0028]) at the registrar (read as first entity and registrar server; see [0028]).

The invention as disclosed by Bobde et al. fail to disclose said first network element and registrar server operable to send a notification from the first network element to the second network element in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses an application server (read as first network element and registrar server) forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080}.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, in the related field of endeavor Requena clearly discloses second network element separate from the first network element (see figs. 8, 10, 15, 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang with the

teachings of Requena in order to reduce loading in one server and provide more efficient processing.

Consider **claim 12** in view of claim 11, Bobde et al. as modified by Wang disclose a communication system further comprising an event header (read as event package [0030]; since the header inherently defines the type of package) associated with said change in presence of computing device (read as an event) ([0030]).

Consider **claim 13** in view of claim 12, Bobde et al. as modified by Wang disclose a communication system with a registrar or a registration program (154) (read as first entity; [0029]; figure 3).

Consider **claim 14** in view of claim 13, Bobde et al. as modified by Wang disclose a communication system, wherein the change in registration information relates to presence information ([0028]).

Consider **claim 15** in view of claim 4, Bobde et al. as modified by Wang disclose a communication system, wherein a presence agent (152) (read as second entity) is a presence server ([0028]).

Consider **claim 16** in view of claim 1, Bobde et al. as modified by Wang disclose a communication system, wherein the system (read as invention) operates in accordance with a session initiation protocol or SIP ([0022]).

Consider **claims 17 and 36**, Bobde et al. disclose a network element and a registrar server (see figure 3) comprising:

storage circuitry configured to maintain registration information (see [0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph

[0029] to process registration information, therefore it inherently would have storage circuitry to maintain registration information) from user (103) and user (107) (read as plurality of users; see figure 3);

receiving circuitry configure to receive notifications (read as receiving a subscribe message; [0028]; figure 3) of changes in the presence of computing devices (read as an event) from a registrar (154) (read as first entity), wherein the change in the presence of computing devices (read as event) is associated with an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first entity; [0028]) at the network element (figure 3);

receiving circuitry configured to receive a register message ([0028]) from at least first user (read as one user), said register message changing the registration information (by way of processing presence information) of said at least first user (read as one user) ([0028]);

The invention as disclosed by Bobde et al. fail to disclose transmitting circuitry configured to send a notification to the first entity and presence server in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses inherently a transmitting circuitry in the application server (read as first entity and registrar server) forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, in the related field of endeavor Requena clearly discloses second network element separate from the first network element (see figs. 8, 10, 15, 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang with the teachings of Requena in order to reduce loading in one server and provide more efficient processing.

Consider **claims 18 and 37**, Bobde et al. disclose a network element and presence server (see figure 3) comprising:

storage circuitry configured to maintain presence information (read as information) associated with said first user (103) and second user (read as plurality of users), wherein said information is dependent on the registration information ([0028]; [0029]; figure 3), maintained at registrar (154) (read as first entity and registrar server);

transmitting circuitry configured to send notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) to the registrar (154) (read as first entity and registrar server), wherein the

change in the presence of computing devices (read as event) is associated with an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first entity; [0028]);

The invention as disclosed by Bobde et al. fail to disclose receiving circuitry configured to receive a notification from the first entity and registrar server, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses receiving circuitry, inherently, and an application server (read as first entity and registrar server) forwarding information (read as receiving notification) to the presence server in response to SIP REGISTER (1204) message (see [0080]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, in the related field of endeavor Requena clearly discloses second network element separate from the first network element (see figs. 8, 10, 15, 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang with the

teachings of Requena in order to reduce loading in one server and provide more efficient processing.

Claims 8 - 9 and 31 - 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142)** in view of **Wang (U.S. Application # 2002/0131395)** as applied to claims above, in view of **Donovan ("IMPS - Instant Messaging and Presence Using SIP. Fall VON Developers' Conference", Sep. 13, 2000, www.dynamicsoft.com)** and further in view of **Requena (USPN 2007/0124472)**.

Consider **claims 8 and 31** in view of claims 1 and 18, Bobde et al. as modified by Wang fail to disclose a method, wherein a third entity sends a subscribe message to the second entity for information associated with said at least one user.

In the related field of endeavor, Donovan discloses a method, wherein a proxy server (read as third entity) sends a subscribe message to presence server (read as second entity for information associated with at least one user (see figure on page 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Donovan with that of Bobde et al. and Wang since this signaling scheme is well known and exists in most applications in the application layer and would provide convenience and conservation of financial resources.

Consider **claims 9 and 32** in view of claims 8 and 18, Bobde et al. as modified by Wang fail to disclose the method, wherein the second entity s ends a notification to

the third entity in response to the notification received at the second entity, wherein said sent notification includes information associated with said at least one user.

In the related field of endeavor, Donovan discloses the method, wherein the presence server (read as second entity) sends an accepted message (read as notification) to the proxy server (read as third entity) in response to the subscribe (read as notification) received at the presence server (read as second entity), wherein said sent accepted message (read as notification) includes information associated with said at least one user (Donovan, page 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Donovan with that of Bobde et al. and Wang since this signaling scheme is well known and exists in most applications in the application layer.

Claims 10 and 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142)** in view of **Wang (U.S. Application # 2002/0131395)** and further in view of **Requena (USPN 2007/0124472).**

Consider **claims 10 and 33** in view of claims 8 and 18, Bobde et al. fail to disclose the method, wherein the third entity is an application server.

In the related field of endeavor, Wang clearly disclose an application server (216) ([0031 - 0040]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to provide various multimedia capabilities other than just presence status.

Conclusion

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fayyaz Alam whose telephone number is (571) 270-1102. The Examiner can normally be reached on Monday-Friday from 9:30am to 7:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Fayyaz Alam

January 29, 2007

EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600